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PATENT TRADEMARK OFFICE

Attorney Docket No. 09/25,783
Application No.: 09/820,812

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re Application of:

David W. CANNELL et al.

Group Art Unit: 1617

Application No.: 09/820,812

Examiner: M. Willis

Filed: March 30, 2001

For: COMPOSITIONS COMPRISING
AT LEAST ONE C₁-C₂₂
SUBSTITUTED C₃ TO C₅
MONOSACCHARIDE UNIT, AND
THEIR USE FOR THE
PROTECTION AND/OR REPAIR
OF KERATINOUS FIBERS

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Assistant Commissioner for Patents
Washington, DC 20231

Sir:

RESPONSE TO RESTRICTION AND ELECTION OF SPECIES REQUIREMENTS

A. Restriction Requirement

In the Office Action mailed February 11, 2002, the Examiner has required
restriction between the following groups of claims:

Group I: Claims 1-100, drawn to a method for protecting keratinous fiber comprising applying a composition comprising at least one compound chosen from C₃ to C₅ monosaccharides substituted with at least one C₁-C₂₂ carbon chain, and to a method for protecting keratinous fiber comprising applying a composition comprising at least one compound chosen from C₃ to C₅ monosaccharides substituted with at least one C₁-C₂₂ carbon chain and at least one film forming agent, classified in class 424, subclass 401; and

Group II: Claims 101-199, drawn to a composition comprising at least one compound chosen from C₃ to C₅ monosaccharides substituted with at least one C₁-C₂₂ carbon chain, to a composition comprising at least

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one compound chosen from C₃ to C₅ monosaccharides substituted with at least one C₁-C₂₂ carbon chain and at least one film forming agent, and kits thereof, classified in class 424, subclass 401.

The restriction requirement, as set forth above and on pages 2-3 of the Office Action, is respectfully traversed. However, to be fully responsive to the restriction requirement, Applicants elect, with traverse, the subject matter of Group II, claims 101-199.

The Examiner states that "the product can be used in a materially different process of using that product." See page 2 of the present Office Action. The Examiner states that it is his position "that a search for compositions comprised of substituted C₅-C₇ carbohydrates with the limitation of methods of protecting at least one keratinous fiber from extrinsic damage or repairing a keratinous fiber following extrinsic damage would not yield references disclosing compositions comprising the claimed compounds such as the Simon reference." See page 3 of the present Office Action.

First, Applicants respectfully point out that both groups of claims recite the limitation "for protecting at least one keratinous fiber from extrinsic damage or repairing at least one keratinous fiber following extrinsic damage." Accordingly, a proper search for either Group I or II may not yield references disclosing "rinsable skincare compositions comprising fatty acid esters of C₅ carbohydrates." See pages 2-3 of the present Office Action discussing Simon (U.S. Patent No. 5,932,234). For example, the Examiner acknowledges that "[t]he compositions are applied to the skin, rather than keratinous fibers." See page 3 of the present Office Action.

Second, the Examiner claims that "there is a serious burden on the examiner to examine both inventions" for the reason discussed above, set forth on page 3 of the

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present Office Action. The Examiner, however, has not shown that examining the above groups together would constitute a serious burden, but merely stated that it would be. According to the present Office Action, Groups I and II are all classified in the identical class and subclass - class 424, subclass 401. Accordingly, a search for these groups of claims will substantially, if not completely, overlap. Thus, for at least the foregoing reasons, Applicants respectfully submit that the restriction requirement is in error and request that the requirement be withdrawn.

B. Election of Species Requirement

The Examiner has also required an election of (a) a single disclosed species of the at least one compound chosen from C₃ to C₅ monosaccharides substituted with at least one C₁-C₂₂ carbon chain, (b) a single disclosed species of the at least one additional sugar, and (c) a single disclosed species of the at least one film forming agent. Applicants traverse these election of species requirements on the grounds that the Examiner has not shown that there would be a serious burden to examine all of the alleged species. In fact, the Examiner has failed to show that any burden exists. See pages 3-4 of the present Office Action.

However, to be fully responsive to the election of species requirement, Applicants elect with traverse, (a) XYLIANCE as at least one compound chosen from C₃ to C₅ monosaccharides substituted with at least one C₁-C₂₂ carbon chain, (b) xylose as at least one additional sugar, and (c) Amphomer LV-71 as the at least one film forming agent. XYLIANCE is disclosed, for example, at page 25, lines 15-18 and in Example 2, and reads on claims 101-105, 115, 121, 123-127, 129-152, 161, 166, 168-172, 174-199

of Group II. Xylose is disclosed, for example, at page 23, line 1, and reads on claims 131, 142-146, 176-177, 187-195, and 197-199 of Group II. Amphomer LV-71 is disclosed, for example, in Example 2, and reads on claims 147-195 and 198-199 of Group II.

As discussed above, Applicants traverse the election of species requirement on the grounds that the Examiner has not shown that there would be a serious burden to examine all of the claimed species. Accordingly, Applicants respectfully request that the full scope of the claimed invention be examined in this application. If the Examiner chooses to maintain the election requirement, however, and the elected species is found to be allowable, Applicants expect the Examiner to continue to examine the full scope of the claimed subject matter to the extent necessary to determine the patentability thereof, *i.e.*, extending the search to the non-elected species, as is the duty of the Examiner according to M.P.E.P. § 803.02 and 35 U.S.C. § 121.

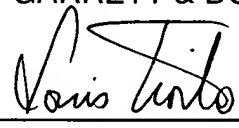
If the Examiner believes a telephone conference would be useful in resolving any outstanding issues, he is invited to call the undersigned at (202) 408-4173.

Please grant any extensions of time required to enter this response and charge any additional required fees to our Deposit Account No. 06-0916.

Respectfully submitted,

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By:

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for Anthony C. Tridico
Reg. No. 45,958

Date: March 11, 2002

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